PATENT/Docket No. PC27788

REMARKS/ARGUMENTS

Claims 1, 10-14, and 16-35 are pending. Claims 2-9, 15, and 36-83 are canceled.

Election/Restrictions

Applicant previously elected group I, claims 1-8, 10-55, 62, 69, 76-83 drawn to a compound or salt wherein A2 and A3 together with the carbon to which they are both bonded, form a pyranyl ring. With an election of the compound of formula 32-1, found exactly in claim 32 for searching purposes. The Examiner had issued a 6 way restriction requirement, groups I-VI. The Examiner states that claims 9, 12, 15, 18-19, 37-61, 63 and 83 are drawn to non elected subject matter. Applicant with this response proposes pending amended claims as conforming with the restriction requirement.

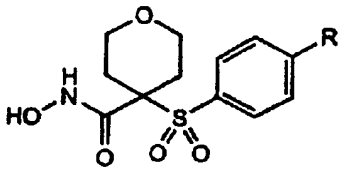
Claim Rejections - 35 USC § 112

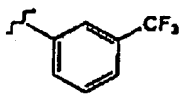
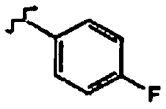
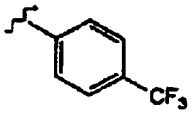
Claims 56, 58-61 were rejected under 35USC§112, first and second paragraph as being indefinite and failing to comply with the written description requirement. Those claims are canceled and the objection is moot.

Claim Rejections - 35 USC § 103

Items 8-10 from the previous Office Action. Claims 1, 4-8, 10-55, and 62 were rejected under 35 USC § 103(a) as being unpatentable over Barta and Chen, specifically the Examiner has cited the following documents and combinations of documents:
Barta WO 99/25687
Barta WO 00/50396
Barta WO 00/69821 in view of Barta WO 99/25687
Chen WO 04/000811 in view of Barta WO 99/25687

All of these documents disclose similar compounds, for example, Barta WO 99/25687, pg 542 – 543 describes compounds having the following structure:



Example Number	Boronic Acid	R	MS (ES) m/z
219	3-(tri-fluoromethyl)-benzeneboronic acid		430 (M+H)
220	4-fluoro-benzeneboronic acid		418 (M+K)
221	4-(tri-fluoromethyl)-benzeneboronic acid		447 ($M+NH_4$)

The compounds specifically described by Barta in '687 therefore differ from those in the instantly elected species in two important respects; first in Barta E1 is phenyl not pyridyl and the E3/E4 references do not represent $-(CH_2)_2$-CF_3.

None of the documents cited by the Examiner, which exemplify a very large number of compounds, describes a compound where the phenyl group in the E1 position is replaced by a heteroaryl group, Barta or Barta and Chen, simply do not describe pyridinyl, pyrazinyl, pyrimidinyl, and benzothiazolyl as being in the E1 position. The compounds exemplified in the documents cited by the Examiner all have a phenyl group next to the $S(O)_2$ moiety. Where a

heteroaryl group is present, it is in the E2 position and is generally a non-aromatic heteroaryl group. Certainly none of the documents cited by the Examiner exemplify a compound with a pyridyl group in the E2 position.

Furthermore, none of the documents cited by the Examiner describe compounds where the E3/E4 moiety represents a $-(CH_2)_2$-CF_3 group. While it may have been hypothetically possible to make the currently claimed compounds, given Barta and Chen, only if one skilled in the art can "at once envisaged" the desired compounds can they be considered obvious. See *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). In addition "one may look to the preferred embodiments to determine which compounds can be anticipated." MPEP section 2131.02.

The Examiner has put forward a number of arguments as to how one having ordinary skill in the art would modify E1 to heteroaryl from phenyl. For example, the Examiner has suggested that the exemplification of other related compounds would lead the skilled person to make such a modification. However, given the very large number of compounds exemplified in the cited documents, and given that all of the examples have a phenyl group in the E1 position with no examples of a pyridyl group in the E1 position, given there are no pyridinyl, pyrazinyl, pyrimidinyl, and benzothiazolyl groups in the E2 position in the cited art, it is submitted that there is no suggestion in the art to make such a modification. Without a suggestion in the art to make the specific compounds described herein it is merely hindsight reconstruction to say that any of the Barta references or Barta combined with Chen could be used to inspire and then lead one to make these compounds. To establish a *prima facie* case of obviousness there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art but NOT based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The compounds of this invention are not mere analogues of the Barta compounds. A specific heteroaryl group like pyridyl is a very different group than a phenyl group. One cannot assume the two different groups will behave the same. Here there is not just one but two distinct structural differences between the compounds in the pending claims and those of Barta.

The Examiner has failed to provide prior art descriptions related to the E3/E4 substituents. It is submitted that the instantly elected species are not obvious over the art cited since there is nothing in these documents to suggest such a combination of modifications, i.e. modifying E1 to heteroaryl from phenyl **and** introducing $-(CH_2)_2$-CF_3 as the E3/E4 substituent. The E3/E4 substituents alone make the compounds distinct and non-analogous from the Barta compounds. Neither of the two modifications are suggested by Barta. The compounds presented in the pending claims are not *prima facie* obvious over the compounds of Barta or Barta in combination with Chen. The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2s 1550,1552 (Fed. Cir 1994).

PATENT/Docket No. PC27788

Double Patenting

Claims 1, 4-8, 10-11, 13-14, 16-17, 20-36 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claim 1 of copending Application No. 11/27-391 in view of claim 1 of US 6,890,937.

Claims 1, 4-8, 10-11, 13-14, 16-17, 20-23, 26-36 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 67-70, 72-78, 103, 105-106,112 of copending Application No. 10/747796 in view of claim 1 of US 6,890,937.

Claims 1, 4-8, 10-11, 13-14, 16-17, 20-36 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-4, 6-12, 14-19 of US patent No. 6, 541,489.

Claims 1, 4-8, 10-11, 13-14, 16-17, 20-36 were rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-5, 11-15, 17-23, 25, 27-30, 32-36, 38-39 of US patent of US 6,890,937.

The claims above have been given a provisional rejection of nonstatutory obviousness type double patenting for the reasons given above. Given the substantial amendments to the claims and for all of the reasons given above applicant now considers the nonstatutory obviousness type double patenting rejection moot. Should the currently pending claims be considered allowable then applicant would be willing to consider an appropriate double patenting rejection and consider filing a terminal disclaimer if appropriate in order to send the allowed claims to grant.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and claims 1, 10-4, and 16-35 are in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. If the Examiner believes that personal communications will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this application is respectfully requested.

Respectfully submitted,

Thomas A Wootton Date: 17 January 2007

Thomas A. Wootton, Attorney
Registration No. 35,004
Pfizer Inc.
7000 Portage Road
Kalamazoo, Michigan 49001
Telephone No. (269) 833-7914 or (269) 833-9500
Telefax No. (269) 833-8897 or (269) 833-2316

FORM AMEND
Rev. 5/27/03